



IN THE

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SUPREME COURT OF THE UNITED STATES

October Term, 1948

No. 753



R. G. McTOWN, Inc. & Corporation

GARWOOD INDUSTRIES, INC. & Corporation

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IN THE
Supreme Court of the United States

October Term, 1945
No. 753.

R. G. LE TOURNEAU, INC., a Corporation,
Petitioner,

vs.

GAR WOOD INDUSTRIES, INC., a Corporation,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI.

Opinions Below.

This case is before the Court on Petition for a Writ of Certiorari to the United States Circuit Court of Appeals for the Ninth Circuit to review a decree of the Circuit Court of Appeals [R. 681] affirming a judgment [R. 64-65] entered by the United States District Court for the Northern District of California, Southern Division, adjudging that claims 2, 5, 7, 20 and 22 of Le Tourneau Patent No. 1,963,665 are invalid for want of invention.

The District Court rendered a written opinion [R. 53-57] which is reported in 51 Fed. Supp. 977, and entered Findings of Fact and Conclusions of Law [R. 57-63]. The opinion of the Circuit Court of Appeals [R. 672-681] is reported in 151 Fed. (2d) 432.

We submit that this case presents no reason or ground for the grant of certiorari such as is required by Rule 38, subdivision 5 of this Court. No court has sustained any of the patent claims in suit, and there is no conflict of decision with respect to the validity of such claims. This Court has uniformly indicated that it will not review concurrent findings of invalidity for want of invention in the absence of any conflicting decision sustaining the validity of the claims.

The record and opinions below in this case do not present the single question which Petitioner asks (page 2) be reviewed and determined by this Court. Such a question would be presented, to use Petitioner's wording of the question, only "where invention was required to conceive the idea of combining old elements to produce an improved result. * * *" The Petition and accompanying Brief erroneously represent that the record and decisions below show this to be true of the claims in suit. To the contrary, the record contains no evidence that the claims in suit embody any such alleged inventive idea, and there is nothing in the opinions or findings below to support Petitioner's unwarranted assumption of such fact. The question is therefore one which does not exist in the case, and this Court could not find in the case the necessary basis upon which to determine the question, assuming that the Court was inclined to do so.

In affirming the findings of the Trial Court that the claims in suit did not involve more than the exercise of ordinary mechanical skill and knowledge, and did not

require invention, the Circuit Court of Appeals followed and expressly applied the decision of this Court in *Cuno Engineering Corp. v. Automatic Devices Corp.* 314 U. S. 84. The decisions below are not in conflict with the opinion of this Court in *National Cash Register Co. v. Boston Cash Indicator & Recorder Co.*, 156 U. S. 502. Indeed, as noted in the opinion of the Circuit Court of Appeals (680), the express wording at page 515 of that opinion refutes Petitioner's argument.

We re-state the case only insofar as is necessary to correct the inaccuracies and omissions in Petitioner's statement.

Statement of the Case.

The claims in suit of Patent No. 1,963,665 [R. 523-537] involve only additions to the prior Le Tourneau Patent No. 1,857,157 [R. 629-637]. As found by the Trial Court [Finding No. 8; R. 59] these consist merely in the addition of an auxiliary front bowl and the connection of the front bowl for actuation by the same cable system present in Patent No. 1,857,157. Both of the courts below have found that neither of these additions involved any patentable invention.

The addition of the front bowl presented no innovation in the art [Finding No. 9; R. 60]. As said in the opinion of the Circuit Court of Appeals [R. 676]:

"It is not claimed herein that novelty or invention were involved in the addition of an auxiliary front bowl to appellant's scraper, for the prior art reveals

several instances of scrapers equipped with a front bowl or apron, namely, Ball Patent 1,593,007 (1926), Pfeil Patent 1,293,536 (1919), and the Bodinson camelback and clamshell scrapers (manufactured and used during 1930 and 1931)."

The use of the cable system of the prior Le Tourneau Patent No. 1,857,157 to actuate the front bowl of the patent in suit, No. 1,963,665, did not require the exercise of invention and involved nothing more than the exercise of ordinary mechanical and engineering skill [Findings Nos. 10-16; R. 60-61]. As said by the Circuit Court of Appeals [R. 677-678]: "The findings outlined in the preceding paragraph are clearly supported by substantial evidence, and a study of the record reveals no contrary evidence."

The alleged novelty of the claims in suit is misrepresented to this Court by Petitioner (p. 8). It is not true that: "No previously known scraper provided with similar bowls for loading, carrying and discharging earth had had a mode of operation in which the discharge was automatically caused to take place sequentially instead of simultaneously." To the contrary, the Trial Court found [R. 61]:

"14. The Dunbar Patent No. 1,174,834 discloses the utilization of a single cable and pulley system as a common means to actuate in sequential order the front and rear bowls of a drag line bucket."

As said by the Circuit Court of Appeals [R. 678]:

“* * * It is true, as appellant points out, that Dunbar's patent was not designed for the same type of work as a wheeled scraper.* However, the district court was referring to the system of cables and pulleys used therein in connection with a dirt-moving bowl; in that respect the patent was worthy of consideration herein. Also ample other evidence substantially supports the finding as to prior knowledge and use of cable systems.”

Both courts below concurred in holding that the additions in the patent in suit No. 1,963,665 to the prior Le Tourneau Patent No. 1,857,157 involved nothing more than exercise or ordinary mechanical and engineering skill and did not require invention. There is not the slightest basis in the opinions or findings of either Court for the assumption that invention was required to conceive the idea of combining or making these additions upon which Petitioner predicates the single question asked to be reviewed and determined by this Court.

*The claims in suit do not call for a wheeled scraper.

ARGUMENT.

(a) In view of the concurrent findings of the courts below that the claims in suit are invalid for want of invention, and in the absence of any conflict of decision, this is clearly not a proper case for the grant of a Writ of Certiorari. This Court has recently announced that it will not disturb concurrent findings as to the validity of patent claims where there is evidence to support them and no conflict of decision. (*Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U. S. 364, 367; see also to the same issue, *General Talking Pictures Corp. v. Western Elec. Co.*, 304 U. S. 175.

As said by Mr. Justice Jackson in *Tennessee Coal I. & R. Co. v. Muscoda Local No. 123*, 321 U. S. 590:

“A seasoned and wise rule of this court makes concurrent findings of two courts below final here in the absence of very exceptional showing of error. *Goodyear Tire & Rubber Co. v. Ray-O-Vac. Co.*, (321 U. S. 275); *District of Columbia v. Pace* (320 U. S. 698); *Baker v. Schofield*, 243 U. S. 114, 118, 61 L. Ed. 626, 630; *Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U. S. 361, 367, 86 L. Ed. 1537, 1540, 62 S. Ct. 1179.”

(b) The case does not present the single question which Petitioner asks to be reviewed and determined by this Court. Such question is predicated upon the assumption that invention was required to conceive the abstract idea of making the additions to the prior *Le Tourneau* Patent No. 1,857,157, although conceding that such additions could be made by the exercise of mere mechanical

skill. Nowhere in the opinions of either of the courts below, or in the record, is there any finding or showing that any invention was involved or required in such abstract idea, even assuming that patentable invention might reside in an abstract idea. This Court should not be called upon to determine a question which is predicated upon an assumption of fact for which there is no support in the case. In any event, the fallacy in Petitioner's proposition is manifest. It is an elementary principle of patent law that invention cannot reside in a mere abstract idea. As said by this Court in *Burr v. Duryee*, 1 Wall, 531, 579: "We find here no authority to grant a patent for a 'principle' or a 'mode of operation,' or an idea, or any other abstraction."

(c) This case involves no new or unsettled proposition of law. The Circuit Court of Appeals applied to the undisputed facts, the recent ruling of this Court in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84. In view of the decision in that case, and the many decisions of this Court preceding it to the same effect, it is idle for Petitioner to urge that a patent may be sustained for the exercise of mere mechanical and engineering skill. The decisions below are not in conflict with the opinion of this Court in *National Cash Register Co. v. Boston Cash Indicator & Recorder Co.*, 156 U. S. 502. As noted in the opinion of the Circuit Court of Appeals (p. 680), the express wording, at page 515 of that opinion, establishes that the decision in that case is not authority for Petitioner's proposition.

Conclusion.

We submit that this case does not present any sufficient reason for the grant of a Writ of Certiorari within the rulings and practice of this Court. The case involves merely concurrent Findings of Fact that the claims in suit involve merely the exercise of ordinary mechanical and engineering skill and did not require invention.

The case presents no disputed proposition of patent law, and the decisions below do not conflict with any applicable decision of this Court.

Respectfully submitted,

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